



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,871	11/17/2003	John M. Epley	103419-0003	5600
35940	7590	07/02/2008		
ATER WYNNE LLP				
222 SW COLUMBIA, SUITE 1800				
PORTLAND, OR 97201-6618				
EXAMINER				
HOEKSTRA, JEFFREY GERDEN				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
07/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/715,871

**Applicant(s)**

EPLEY, JOHN M.

**Examiner**

JEFFREY G. HOEKSTRA

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission(s) filed on 11/28/07 and 05/14/2008 have been entered.

### ***Notice of Amendment***

2. In response to the amendments filed on 11/28/07 and 05/14/2008 and the petition decision mailed on 06/23/08, amended claim(s) 1, 7, and 20 is/are acknowledged. The current rejections of the claim(s) 1-8 and 20-23 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Densert et al (US 6,159,171, hereinafter Densert) in view of Galiana et al. (US 5,942,954, hereinafter Galiana) and in further view of Gallery (US 5,900,849).

5. Densert (US 6,159,171) discloses the claimed invention including the following:

6. For claims 1, 7, and 20-23, Densert discloses a head stabilized medical device (1), comprising:

- plural different vestibular-parameter measuring/ modifying vestibular-parameter data delivering and data receiving devices (elements 19,20,28 and 30) anchored to said frame; and
- a communication structure (the wires as seen in Figures 1-2), for operatively connecting, transmitting and receiving, vestibular-relevant parameter data devices to a computer structure (29) (column 4 lines 49-52) capable of executing real-time vestibular diagnosis/treatment algorithms with feedback responses (column 7 lines 3-6) effective to alter air-pressure stimuli.

7. For claims 2 and 8, Densert discloses air-pressure modifying vestibular measuring/modifying devices (column 1 lines 6-48).

8. For claims 3-6, Densert discloses a sound delivering device creating pressure waves through air removably insertable into the ear comprising a tubular body (24) with a tapered insertion bulb or nozzle (25) effective to sealably engage the ear, and capable of piercing the tympanic membrane, and having a digitally manipulated maneuverable enlargement region (17 and 18) connected to said body at a proximal location of the inserted end.

9. Therefore for claims 1-8 and 20-23, Densert discloses the claimed invention, as set forth above, except for expressly disclosing (A) a stabilized head-dependent wearable frame structure configured to control a visual input by at least partially obstructing the subject's normal visual range and including an image capture device

comprising an integrated eye-movement monitoring means and (B) the head-wearable frame structure configured with or including an eye-enclosing vision-obstructing goggle-like visual-input isolating portion to control visual input by substantially obstructing or limiting the subject's normal visual range and securable to a subject's head in a manner causing the frame structure to function as a non-relative motion unit with respect to the subject's head, wherein the an eye-enclosing vision-obstructing goggle-like visual-input isolating portion provides controlled visual input and includes an integrated visual display or image-displaying device, an image capture device, and a light-emitting structure. .

10. Galiana teaches and shows (A) (as best seen in Figures 3 and 4) a vestibular measuring/modifying device (30), comprising: a stabilized head-dependent wearable frame structure (32) configured to control a visual input via a display (12) by at least partially obstructing the subject's normal visual range (column 2 line 39 – column 3 line 32 and column 4 lines 37-52) and including an image capture device (14) comprising an integrated eye-movement monitoring means (column 4 lines 53-60). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Densert and Galiana. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Densert with the

components as taught by Galiana to achieve the predictable results of increasing the diagnostic efficacy of a vestibular diagnostic device with positional stabilization for accurate correlation of data.

11. Thus for claims 1-8 and 20-23, Densert in view of Galiana teaches the claimed invention, as set forth above, except for expressly disclosing (B) the head-wearable frame structure configured with or including an eye-enclosing vision-obstructing goggle-like visual-input isolating portion to control visual input by substantially obstructing or limiting the subject's normal visual range and securable to a subject's head in a manner causing the frame structure to function as a non-relative motion unit with respect to the subject's head, wherein the an eye-enclosing vision-obstructing goggle-like visual-input isolating portion provides controlled visual input and includes an integrated visual display or image-displaying device, an image capture device, and a light-emitting structure.

12. Gallery teaches a head-wearable frame structure (16) (as best seen in Figure 3) configured with or including an eye-enclosing vision-obstructing goggle-like visual-input isolating portion (20) to control visual input by substantially obstructing or limiting the subject's normal visual range (column 2 lines 12-63, column 3 lines 27-56, and column 4 line 22 - column 5 line 60) and securable to a subject's head in a manner causing the frame structure to function as a non-relative motion unit with respect to the subject's head (as best seen in Figure 3), wherein the an eye-enclosing vision-obstructing goggle-like visual-input isolating portion provides controlled visual input (column 2 lines 12-63, column 3 lines 27-56, and column 4 line 22 - column 5 line 60) and includes an

Art Unit: 3736

integrated visual display or image-displaying device (60), an image capture device comprising (62), and a light-emitting structure (18) (column 3 lines 27-56 and column 4 line 66 – column 5 line 4 ). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Densert in view of Galiana and Gallery. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Densert in view of Galiana with the components as taught by Gallery to achieve the predictable results of providing and controlling visual input or stimuli to a subject's eyes.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-8 and 20-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

Art Unit: 3736

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J.H./

Jeff Hoekstra  
Examiner, Art Unit 3736

/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736